

REMARKS

In the Office Action, the Examiner rejected claims 1-9, 11-25, and 31-35, objected to claim 10, and indicated claims 26-30 as allowable. Regarding claim 10, the Examiner noted that claim 10 recites allowable subject matter and would be allowable if rewritten in independent form. Applicants thank the Examiner for noting the allowable subject matter recited in the instant claims. By the present Response, Applicants have amended claims 1, 8, 17, 27, and 31, canceled claims 3, 4, and 18 without prejudice, and added new claims 36-38. Regarding the new claims, Applicants respectfully assert that no new matter has been added. In summary, claims 1, 2, 5-17, and 19-38 are pending in the present application. In light of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-9, 11-25, and 31-35 as obvious in view of various references. As discussed further below, Applicants respectfully assert that the instant claims, as pending, are patentable over the cited references taken alone or in combination.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). With the foregoing in mind, Applicants respectfully assert that the instant claims are patentable and in condition for allowance.

First Rejection Under Section 103

In the Office Action, the Examiner rejected claims 1-9, 11-17, 19-25, and 31-35 under 35 U.S.C. § 103(a) as obvious in view of the Roos reference and in further view of the Eberle reference. Applicants, however, respectfully assert that the pending claims are patentable over the Roos-Eberle reference combination. Simply put, Applicants respectfully assert that the instant claims recite features not found in the Roos and Eberle references, taken alone or in combination.

Amended Independent Claim 1 and the Claims Depending Therefrom

Amended independent claim 1 recites, *inter alia*, “a second member coupled to the first member via the engagement member, wherein pivotal actuation of the first member in a direction generally tangential to the body directs axial translation of the second member from a first position to a second position such that the *camming surface defines* the first and second positions.” (Emphasis added.) Applicants respectfully assert that these features are not found in the Roos and Eberle references, taken alone or in combination.

The Roos reference discloses a pair of tubular members 1 and 2 that engage with one another. *See* Roos, p. 1, ll. 33-36. To secure the engagement between these two tubular members, the Roos reference discloses a hooked member 19 coupled to one of the tubular members 2 that cooperates with trunnions 7 located on the corresponding tubular member 1. *See id.*, p. 1, ll. 70-73. Actuation of the hooked members 19 is controlled by turnable bellcrank members 15. *See id.*, p. 1, l. 99-p. 2, l. 9. Specifically, the lever arms 15 are coupled to the hook members 19 via a “*pivotal connection*.” *See id.*, p. 1, ll. 80-86. However, the Roos reference provides no evidence to support the assertion that this pivotable coupling includes a slot or a camming surface, let alone a *camming surface that defines* the position of the hooked arm 19. Rather, the fact that the engagement between the hooked arm 19 and the lever arm 15 is defined simply as a “pivotal connection” suggests that the location of the unnumbered pin remains static with respect to the lever arm 15. That is, any translation of the hooked arm 19, whether axial or radial, is defined by distance between the pivotal coupling (i.e., the unnumbered pin) about pivot pin 14, and not by any interaction between the unnumbered pin and lever arm 15. Thus,

Applicants respectfully assert that the Roos reference does not disclose a camming surface, let alone a camming surface that defines first and second axial positions of a member, as recited in the instant claim.

Additionally, the Eberle reference fails to obviate the deficiencies of the Roos reference discussed above. The Eberle reference discloses handle levers 64 that pivot *radially* or perpendicular to the body 22 of the assembly. *See* Eberle, col. 4, ll. 60-62. Moreover, the Eberle reference discloses that actuation of the jaw bar 32 is managed by a *linkage* assembly. *See id.*, col. 4, ll. 49-67. Accordingly, the device of Eberle actuates the jaw bar 32 simply by coupling a linkage rod 74 to the jaw bar 32, thereby articulating the linking rod 74 and the jaw bar 32. That is, the *length of the linkage rod* defines that position of the jaw bar 32. Accordingly, the Eberle reference is absolutely devoid of a camming surface, let alone a camming surface that defines the first and second axial positions, as recited in the instant claim.

Therefore, Applicants respectfully assert that independent claim 1 and its respective defendant claims 2 and 5-7 are patentable over the Eberle and Roos references, taken alone or in combination. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of the instant claims.

Amended Independent Claim 8 and the Claim Depending Therefrom

Amended independent claim 8 recites, *inter alia*, “a first member having a camming surface at least partially defining a slot . . . an engagement member disposed in the slot . . . wherein the engagement member is disposable *at a plurality of locations* with respect to the *slot*.” (Emphasis added.) Applicants respectfully assert that these features are not found in the Roos and Eberle references, taken alone or in combination.

As discussed above, the Roos reference teaches that the pivot pin 14 pivots about an unnumbered pin, which is coupled to the tubular body 2. *See* Roos, Fig. 1; p. 1, ll. 59-61. However, the pivot pin 14 is static with respect to the aperture of the lever arm 16 in which it resides. Moreover, the unnumbered pin is also static with respect to the aperture of the lever

arms 15 and 16 in which it resides. *See id.* Accordingly, the neither the unnumbered pin nor the pivot pin 14 is disposable at a plurality of locations with respect to a slot, as recited in the instant claim. Rather, the pivot pin 14 and the unnumbered pin are *fixed* with respect to the respect apertures in which they reside.

Furthermore, the Eberle reference does not obviate the deficiencies of the Roos reference. As discussed above, the device of the Eberle reference actuates a jaw bar 32 simply by coupling a linkage rod 74 to the jaw bar 32, thereby articulating the linkage rod 74 and the jaw bar 32. Accordingly, the Eberle reference is absolutely devoid of a slot and an engagement member disposable at a plurality of locations with respect to the slot, as recited in the instant claims.

Accordingly, Applicants respectfully assert that independent claim 8 and its respective defendant claims 9-16 are patentable over the Eberle and Roos references, taken alone or in combination. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of the instant claims.

Amended Independent Claims 17 and 20 and the Claims Depending Therefrom

Amended independent claims 17 and 20 each recite, *inter alia*, “a second member *non-rotatably* coupled to the body, wherein rotational actuation of the first member in a direction *generally tangential* to the body actuates the second member in an axial direction with respect to the body.” (Emphasis added.) Applicants respectfully assert that the cited references, taken alone or in combination, do not disclose these features.

Prior to addressing the substance of the instant claims, Applicants respectfully remind the Examiner that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Moreover, a claim must not be distilled down to its “gist” or “thrust,” as this disregards the requirement of analyzing the subject matter as a whole. *See W.L.Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

As discussed above, the Roos reference discloses a device in which the hooked members 19 *pivot* about pivot pin 14 to secure the first and second tubular members. *See* Roos, Fig. 1; p. 1, ll. 59-64. Moreover, the hooked members 19 pivot about an unnumbered pivot point to actuate. *See id.*, Fig. 1. Accordingly, the Roos reference discloses members 15 and 19 that both *pivot* to operate and, as such, does not disclose a member *non-rotatably* couple to the body that actuates axially in response to a rotational movement as recited in the instant claim. That is, the device of the Roos reference *cannot* and *does not* disclose a member that is *non-rotatably* coupled to the body and that actuates axially in response to rotation of another member in a direction *generally tangential to body*, as recited in the instant claim.

Furthermore, Applicants respectfully assert that the Eberle reference fails to obviate the deficiencies of the Roos reference, as discussed above. In the Eberle reference, moving handles levers 64 *radially* toward and away from the body 22 actuates the jaw bar 32. *See* Eberle, col. 4, ll. 54-62. Accordingly, the Eberle reference fails to disclose a *non-rotatable* second member that actuates axially in response to movement of a first member in a direction *generally tangential* to the body, as recited in the instant claim.

Therefore, Applicants respectfully assert that independent claim 17 and its respective dependent claim 19 and independent claim 20 and its respective dependent claims 21-25 are patentable over the cited references taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and allowance of the instant claims.

Independent Claim 31 and the Claim Depending Therefrom

Amended independent claim 31 recites, *inter alia*, “driving the second member in an axial direction with respect to the body via the interaction between the engagement member and the camming surface, such that the *camming surface defines* the axial position of the second member.” (Emphasis added.) Applicants respectfully assert that the cited references, taken alone or in combination, do not disclose these features.

As discussed above, the engagement between the hooked arm 19 and the lever arm 15 in the device of the Roos reference is defined simply as a “pivotal connection” and, as such, suggests that the location of the unnumbered pin remains *static* with respect to the lever arm 15. That is, any translation of the hooked arm, whether axial or radial, is defined *by distance between the pivotal coupling* (i.e., the unnumbered pin) about pivot pin 14, and not by any interaction between the unnumbered pin and lever arm 15. Thus, Applicants respectfully assert that the Roos reference does not disclose a camming surface, let alone a camming surface that defines first and second axial positions of a member, as recited in the instant claim.

Additionally, the Eberle reference fails to obviate the deficiencies of the Roos reference as discussed above. The Eberle reference discloses handle levers 64 that pivot radially or perpendicular to the body 22 of the assembly. *See* Eberle, col. 4, ll. 60-62. Moreover, the Eberle reference discloses that actuation of the jaw bar 32 is managed by a *linkage* assembly. *See id.*, col. 4, ll. 49-67. Accordingly, the device of Eberle actuates the jaw bar 32 simply by coupling a linkage rod 74 to the jaw bar 32, thereby articulating the linkage rod 74 and the jaw bar 32. That is, the length of the linkage rod 74 defines the position of the jaw bar 32. Thus, the Eberle reference is absolutely devoid of a camming surface, let alone a camming surface that defines the first and second axial positions as recited in the instant claim.

Therefore, Applicants respectfully assert that independent claim 31 and its respective dependent claims 32-35 are patentable over the cited references taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and allowance of the instant claims.

Second Rejection Under Section 103

In the Office Action, the Examiner rejected claims 1, 6, 7, 17-19, 20, 23, 24, and 31-35 under 35 U.S.C. § 103(a) as obvious in view of the Eberle reference and the Caregnato reference (U.S. Patent No. 3,494,641). Applicants, however, respectfully assert that pending claims are not obvious in view of the cited references, because the cited references fail to disclose all of the features recited in the instant claim, and because the cited references lack the requisite motivation for combination.

Amended Independent Claim 1 and the Claims Depending Therefrom

Amended independent claim 1 recites, *inter alia*, “a second member coupled to the first member via the engagement member, wherein pivotal actuation of the first member in a direction generally tangential to the body directs axial translation of the second member from a first position to a second position such that the *camming surface defines* the first and second positions.” (Emphasis added.) Applicants respectfully assert that these features are not found in the Caregnato and Eberle references, taken alone or in combination.

Firstly, the Eberle reference discloses handle levers 64 that pivot radially or perpendicular to the body 22 of the assembly. *See* Eberle, col. 4, ll. 60-62. Secondly, the Eberle reference discloses that actuation of the jaw bar 32 is managed by a *linkage* assembly. *See id.*, col. 4, ll. 49-67. Accordingly, the device of Eberle actuates the jaw bar 32 simply by coupling a linkage rod 74 to the jaw bar 32, thereby *articulating* the linking member and the jaw bar. Accordingly, the Eberle reference is absolutely devoid of a *camming surface* let alone a camming surface that defines the first and second axial positions as recited in the instant claim.

Secondly, the Caregnato reference does not obviate the deficiencies of the Eberle reference. The Caregnato reference discloses various embodiments in which the grasping arms 10 and 110 are pivotably *fixed* to the body 1. *See* Caregnato, Figs. 1-5. Moreover, each of the actuation levers 14 are also pivotably *fixed* to the body by pivot pin 5. *See id.* Indeed, neither the arms nor levers of the device of Caregnato are even capable of moving in an axial direction with respect to the body. Moreover, the *distance between the various pivot points defines* the positions of the various arms and levers with respect to the body and with respect to one another. In other words, the Caregnato reference does not disclose a camming surface, let alone a camming surface that defines the axial position of a member, as recited in the instant claims.

Therefore, Applicants respectfully assert that independent claim 1 and its respective dependent claims 6 and 7 are patentable over the cited references, taken alone or in combination.

With the foregoing in minds, Applicants respectfully request reconsideration and allowance of the instant claims.

Amended Independent Claims 17 and 20 and the Claim Depending Therefrom

Amended independent claims 17 and 20 each recite, *inter alia*, “a second member *non-rotatably* coupled to the body, wherein rotational actuation of the first member in a direction *generally tangential* to the body actuates the second member in an axial direction with respect to the body.” (Emphasis added.) Applicants respectfully assert that the cited references, taken alone or in combination, do not disclose these features.

Firstly, and as discussed above, the Caregnato reference discloses arms and levers that are only capable of *pivotal movement* with respect to the body. Thus, the Caregnato reference *cannot* and *does not* disclose a member axially positionable with respect to the body, as recited in the instant claim.

Secondly, Applicants respectfully assert that the Eberle reference fails to obviate the deficiencies of the Roos reference. In the Eberle reference, moving handles levers 64 *radially* toward and away from the body 22 actuates the jaw bar 32. *See* Eberle, col. 4, ll. 54-62. Accordingly, the Eberle reference fails to disclose a *non-rotatable* second member that actuates axially in response to movement of a first member in a direction *generally tangential* to the body, as recited in the instant claim.

Therefore, Applicants respectfully assert that independent claim 17 and its respective dependent claim 19 and independent claim 20 and its respective dependent claims 23 and 24 are patentable over the cited references taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and allowance of the instant claims.

Independent Claim 31 and the Claim Depending Therefrom

Amended independent claim 31 recites, *inter alia*, “driving the second member in an axial direction with respect to the body via the interaction between the engagement member and the

camming surface, such that the *camming surface defines* the axial position of the second member.” Applicants respectfully assert that the cited references, taken alone or in combination, do not disclose these features.

As discussed above, the Eberle reference discloses handle levers 64 that pivot radially or perpendicular to the body 22 of the assembly. *See* Eberle, col. 4, ll. 60-62. Secondly, the Eberle reference discloses that actuation of the jaw bar 32 is managed by a *linkage* assembly. *See id.*, col. 4, ll. 49-67. Accordingly, the device of Eberle actuates the jaw bar 32 simply by coupling a linkage rod 74 to the jaw bar 32, thereby articulating the linkage rod 74 and the jaw bar 32. That is, the length of the linkage rod 74 defines the position of the jaw bar 32. Accordingly, the Eberle reference is absolutely devoid of a camming surface, let alone a camming surface that defines the first and second axial positions as recited in the instant claim.

Furthermore, the Caregnato reference does not obviate the deficiencies of the Eberle reference. The Caregnato reference discloses various embodiments in which the grasping arms 10 and 110 are pivotably *fixed* to the body 1. *See* Caregnato, Figs. 1-5. Moreover, each of the actuation levers 14 are also pivotably *fixed* to the body by pivot pin 5. *See id.* Indeed, neither the arms nor levers of the device of Caregnato are even capable of moving in an axial direction with respect to the body. Moreover, the *distance between the various pivot points defines* the positions of the various arms and levers with respect to the body and with respect to one another. In other words, the Caregnato reference does not disclose a camming surface, let alone a camming surface that defines the axial position of a member, as recited in the instant claims.

Therefore, Applicants respectfully assert that independent claim 31 and its respective dependent claims 32-35 are patentable over the cited references, taken alone or in combination. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of the instant claims.

Cited References Lack the Requisite Motivation For Combination

Applicants respectfully remind the Examiner that the burden of a *prima facie* case of obviousness rests with the Examiner. See *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Indeed, to establish a *prima facie* case of obviousness, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Moreover, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Furthermore, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Additionally, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Indeed, the Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Moreover, avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one employ such hindsight. See *id.*

With regard to the cited references, the Examiner has failed to present *objective* evidence for combining combine the cited references to reach the instant claims. Indeed, the Eberle reference discloses a particular mechanism in which radial actuation of the lever arms 64 with respect to the body provides a mechanical advantage in securing the body to an outlet or inlet. *See* Eberle, col. 6, ll. 19-30; col. 4, ll. 60-61. Nothing in the Eberle reference suggests that the disclosed *linkage* mechanism can be modified in accordance with the *pivotal* mechanism of the Caregnato reference. Moreover, nothing in the Caregnato reference suggests combination with the device of the Eberle reference. Indeed, the mere desirability of the end result: “since both connectors are equivalent in the manner of operation and relocation of the pivot pin causing tangential movement of the first member would allow the first member to not extend too far out away from the body and thereby operate in a more flush and sleek manner,” is not objective evidence establishing that one of ordinary skill in the art would have found the claim invention obvious in view of the cited references.

Furthermore, it is improper to combine references when the references teach away from the proposed combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. That is, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01. Moreover, a proposed modification or combination cannot render the proposed device inoperative. *See In re Schulpen*, 157 U.S.P.Q. 51 (C.C.P.A 1968).

As discussed above, the Eberle reference discloses handle levers 64 that pivot radially or perpendicular to the body 22 of the assembly. *See* Eberle, col. 4, ll. 60-62. Moreover, the Eberle reference discloses that actuation of the jaw bar 32 is managed by a *linkage* assembly. *See id.*, col. 4, ll. 49-67. More specifically, radially outward movement of lever arms 64 causes the linkage assembly to affect the position of the jaw bar 32. By contrast, the Caregnato device operates through the use of *pivotal* members that are unable to axially move with respect to the

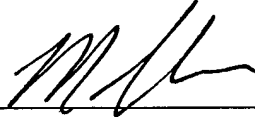
body. Accordingly, the linkage assembly of the Eberle reference cannot be actuated if it were to be axially fixed in place and limited to only pivotal movement, as taught by the Caregnato reference. Accordingly, the combined device of the Eberle and Caregnato reference is inoperable. Indeed, the respective devices would require dramatic redesign to reach the subject matter of the instant claims.

Thus, Applicants respectfully assert that the cited references lack the requisite motivation for combination to reach the instant claims. Therefore, Applicants respectfully request reconsideration and allowance of the instant claims.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



Date: June 4, 2004

Manish B. Vyas
Reg. No. 54,516
Fletcher, Yoder
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545